UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,863	10/30/2000	Jukka Heiska	4925-64	6891

			EXAMINER
27799	7590	09/14/2004	MAURO JR, THOMAS J

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ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/699,863	HEISKA, JUKKA
	Examiner	Art Unit
	Thomas J. Mauro Jr.	2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 May 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>8-15</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>8-15</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>30 October 2000</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

1.   This action is in response to the amendment filed on May 24, 2004. Claims 1-7 have

been cancelled. Claim 15 has been newly added.

2.   Claims 8-15 are pending and are presented for examination. A formal action on the

merits of claims 8-15 follows.

3.   Objection made against the specification has been withdrawn in light of the amendment

providing appropriate corrections.

4.   Objection made against the drawings will be sustained until figures are formally added,

such as the graphic proposed in the amendment showing the system of the present invention.

Claim Objections

5.   Claim 12 is objected to because of the following informalities:

        - Claim 12 recites that it is dependent upon the "apparatus of claim 12." A claim cannot

depend from itself. For purposes of examination, it is assumed this misprint refers back to the

apparatus of claim 8. Appropriate correction is required.

Drawings

6.   The drawings are objected to under 37 CFR 1.83(a) because they fail to specifically show

the structural elements of the system as described in the specification. Any structural detail that

is essential for a proper understanding of the disclosed invention should be shown in the

drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required

in reply to the Office action to avoid abandonment of the application. The objection to the

drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8.   Claims 8-15 are rejected under 35 U.S.C. 102(a) as being anticipated by Carlino et al.

(WO 00/39666).

        With respect to claim 8, Carlino teaches an apparatus for providing data services to

mobile devices in a system comprising a data network, at least one content server accessible via

the data network, at least one gateway for accessing the data network, a mobile telephone

network for communicating between the mobile devices and said at least one gateway, and a

content converter separate from the at least one gateway, separate from the at least one content

server, and connected to the data network **[Carlino -- Figure 1, Abstract and Page 14 lines 19-**

23 - Discloses original document in World Wide Web (WWW) (20), implicitly residing on a

content server, i.e. computer, server, etc., wireless gateway (14), mobile telephone (12) and

content converter (16), separate, i.e. not integral, from the gateway], the apparatus

comprising:

a data store associated with the content converter for storing indications of the

characteristics of each terminal **[Carlino -- Page 33 lines 10-19 -- Database 18 contains**

wireless device preferences, i.e. characteristics, which are specific to the particular wireless

device, i.e. type of display, i.e. number of viewable lines on screen. In order for the

preferences to exist in the database 18, it is required that they were uploaded to content

converter and its associated database];

receiving means at the content converter for receiving content for a particular mobile

terminal from said at least one content server **[Carlino -- Figure 1 and page 18 lines 19-23 --**

Original document from WWW is received at content converter from its source, i.e.

content server];

logic for adjusting content for the particular mobile terminal in the content converter

according to the stored characteristics of the mobile terminal **[Carlino -- Page 9 lines 1-7 --**

Content converter converts original document, i.e. web page, etc., from one markup

language to another markup language, in addition to, following the preferences stored in

the database]; and

sending means for routing the adjusted content through the data network to said at least

one gateway for forwarding to said particular mobile terminal **[Carlino -- Figure 1 and Page 33**

lines 19-23 – Wireless gateway (14), shown in figure 1, both receives requests and sends

converted document to mobile device, i.e. mobile phone].

With respect to claim 9, Carlino further teaches wherein the content is in wireless

application protocol (WAP) format **[Carlino -- Page 33 lines 1-5 – Document is in WAP**

format using WML].

With respect to claim 10, Carlino further teaches wherein the data network is a wide-area

network (WAN) **[Carlino -- Figure 1 – World Wide Web or Internet is used to retrieve**

documents from other servers, computers etc... The Internet is classified as a WAN].

With respect to claim 11, Carlino further teaches wherein the WAN is the Internet

[Carlino -- Figure 1 and Page 14 lines 13-16 – World Wide Web on the Internet].

With respect to claim 12, Carlino further teaches wherein the data store further stores

indications of preferences of the user of each terminal device, and wherein the logic adjusts

content in accordance with stored preferences of the user **[Carlino -- Page 9 lines 1-7 and page**

45 lines 3-13 – Database stores uploaded characteristics of devices and preferences of the

user of the device which is used by the content converter to render documents in a manner

viewable on a particular wireless device].

With respect to claim 13, Carlino further teaches wherein the logic adjusts content in accordance with a preference currently entered by the user and stored **[Carlino -- Page 9 lines 1-7 – Content converter uses preferences and characteristics of users stored in database to adjust the original document, i.e. convert it to format suitable for wireless device. The user can make these preferences at any time and store them in the database]**.

With respect to claim 14, Carlino further teaches wherein the logic adjusts content in accordance with a preference previously stored and currently selected by the user **[Carlino -- Page 9 lines 1-7 and page 45 lines 3-13 – Content converter adjusts content to that of user preferences previously stored, i.e. user stores preferences for baseball scores to render them on wireless device, in a given manner]**.

With respect to claim 15, Carlino teaches a system for converting a mark-up language file into a format for presentation on a mobile terminal comprising:

a content server connected to a wide area network (WAN) for transmitting a mark-up language file over said WAN **[Carlino -- Figures 1, Abstract, page 13 lines 5-6 and page 14 lines 5-18 – Original documents, i.e. web pages in HTML, are accessed over the Internet, i.e. WAN, which implicitly reside on a server, i.e. content server]**;

a content converted connected to said WAN for receiving the mark-up language file over said WAN from the content server, for converting said mark-up language file into a format appropriate for a mobile terminal, and for transmitting the converted mark-up language file over

the WAN [Carlino -- Figure 1, Page 9 lines 1-7, page 18 lines 19-23 and page 33 lines 19-23 –

Original document from WWW is received at converter from its source, i.e. content server,

upon which, it the content converter converts the original document, i.e. web page, etc.,

from one markup language to another markup language by following the preferences

stored in the database. Upon completion, wireless gateway transmits the file over the

network to the mobile device]; and

a gateway between the WAN and a mobile telephone network for receiving the converted

mark-up language file from the content converter and for transmitting the converted mark-up

language file over the mobile telephone network to the mobile terminal [Carlino -- Figure 1 and

Page 33 lines 19-23 – Wireless gateway (14), shown in figure 1, both receives requests and

sends converted document to mobile device, i.e. mobile phone];

wherein said content converter is separate and distinct from said content server and from

said gateway [Carlino -- Figure 1, page 14 lines 19-23 and page 15 lines 6-10 – Content

converter is not integral to the wireless gateway nor the content provider but rather is an

individual component, i.e. distinct from server and gateway]; and

wherein said content converter accesses a database storing the characteristics of the

mobile terminal in order to convert the mark-up language file into a format appropriate for the

mobile terminal [Carlino -- Page 33 lines 10-19 – Database 18 contains wireless device

preferences, i.e. characteristics, which are specific to the particular wireless device, i.e. type

of display, i.e. number of viewable lines on screen. Converter accesses database to obtain

converting information to process the conversion].

Response to Arguments

9.   Applicant's arguments filed May 24, 2004 have been fully considered but they are not

persuasive.

> (A) Applicant contends that the content converter of Carlino is integrated within the
>
> WAP gateway, whereas claim 8 and similarly claim 15 calls for the converter to be
>
> separate from the gateway and content server.
>
> In response to argument A, Examiner demurs to this contention as Carlino distinctly
>
> points out in Figure 1 and on page 14 lines 19-23 that "Figure 1 illustrates the content
>
> converter application 16 as an individual component," and further states "the content
>
> converter 16 can ALSO be integral to the wireless gateway 14 (not illustrated in
>
> figure 1)." This quotation explicitly shows that the converter is *not integral* to the
>
> wireless gateway, although as Carlino points out, it can be. Therefore, the Examiner
>
> accordingly demurs to this assertion that the content converter of Carlino is integral
>
> to the gateway as Carlino explicitly states it is not, as shown in Figure 1.
>
> Even if, *assuming arguendo*, that Carlino does not explicitly teach that the converter
>
> is separate from the gateway, it would have been obvious to a person of ordinary skill

in the art to relocate such a subsystem, i.e. content converter to another server or

proxy. As was upheld in *In re Japikse,* 181 F.2d 1019, 86 USPQ 70 (CCPA 1950),

the mere rearrangement of parts does not by itself provide patentable substance

unless an unexpected result is achieved. In this case, no such result is achieved and

the movement of the converter system from one server to another would have been

obvious.

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

- Mogul (U.S. 6,704,798) discloses a content conversion system which utilizes a proxy

server separate from the content servers and client gateways for performing the

conversions.

11.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Thomas J. Mauro Jr. whose telephone number is 703-605-1234.

The examiner can normally be reached on M-F 8:00a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JACK B. HARVEY
SUPERVISORY PATENT EXAMINER

TJM
September 8, 2004